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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/663,044

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David J. Laverick

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09/26/2006

GARMIN LTD.
C/O GARMIN INTERNATIONAL, INC.
ATTN: Legal - IP
1200 EAST 151ST STREET
OLATHE, KS 66062

EXAMINER

LUU, MATTHEW

ART UNIT

PAPER NUMBER

3663

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/663,044	LAVERICK ET AL.	
	Examiner	Art Unit	
	LUU MATTHEW	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,13,14 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,13,14 and 30-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/25/06</u> 3/7/06 | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Schoenfish (6,370,037).

Regarding claim 1, Schoenfish discloses (Figs. 1 and 2) a navigation assembly for use in a vehicle comprising:

a navigational device (GPS 12); and

a carrying case (Fig. 2, mounting 14 and case 34 of the navigational device 12) sized and configured to removably fit substantially within a tray (cradle 16) of the vehicle and configured to substantially enclose the navigation device (the inside electronic part of the case 32), wherein the case (12 and 32) is configured to conform to the tray (Fig. 2) (Column 3, lines 17-19; and column 5, lines 19-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish (6,370,037) in view of Susko et al (5,996,866).

Regarding claim 31, Schoenfish discloses (Figs. 1 and 2) a navigation assembly for use in a vehicle comprising:

a navigational device (GPS 12); and

a carrying case (Fig. 2, mounting 14 and case 34 of the navigational device 12) sized and configured to removably fit substantially within a tray (cradle 16) of the vehicle and configured to substantially enclose the navigation device (the inside electronic part of the case 32), wherein the case (12 and 32) is configured to conform to the tray (Fig. 2) (Column 3, lines 17-19; and column 5, lines 19-24).

Schoenfish fails to teach wherein the tray is originally installed in the vehicle during manufacture of the vehicle.

However, Susko (5,996,866) discloses (Fig. 1) a vehicle console (12) having a plurality of containing trays. Susko further teaches that one of the tray (drawer 16) is configured to receive a portable phone (22) in slot (18) and sun glasses (22) in slot (20) (Column 2, lines 19-23).

Therefore, it would have been obvious to the person of ordinary skill in the art to store the navigational device (12) of Schoenfish in to the tray (16) of Susko to provide a more convenient storing tray for the portable electronic device and its power cord within

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a the vehicle. This tray would allow the driver to easily access the GPS or portable phone when he needs it (as suggested by Susko, column 1, lines 55-58).

Furthermore, it is obvious that one of ordinary skill in the art to store the navigational device (12) on the vehicle dashboard tray, a cup holder tray, or the right hand console tray, as shown in Fig. 1 of Susko, since this is not critical to the function of the GPS device in the carrying case (40) of Lewis.

Furthermore, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup holder tray, or the driver's right hand console tray (as shown in Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices.

Furthermore, if the vehicle has a tray, then it does not matter where it is come from or what time it is put in.

Regarding claim 40, note the rejection as set forth above with respect to claim 1. Schoenfish further discloses (Fig. 2) no securing mechanism is needed to secure the case (14 and 12) within the tray (58).

Furthermore, Susko (5,996,866) further discloses (Fig. 1) a vehicle console (12) having a plurality of containing trays. Susko further teaches that one of the tray (drawer 16) is configured to receive a portable phone (22) in slot (18) and sun glasses (22) in slot (20) (Column 2, lines 19-23). There if no securing mechanism is needed to secure the portable phone (22) in slot (18) and sun glasses (22) in the tray (16). Furthermore, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup

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holder tray, or the driver's right hand console tray (as shown in Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices without any securing mechanism is needed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 13, 31-36, 40-41, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al (5,859,628) in view of Lewis (GB 2,405,049) and Susko et al (5,996,866).

Regarding claim 1, Ross discloses (Figs. 1-3) a navigation assembly for use in a vehicle comprising:

A navigational device (Fig. 2 shows a PDA 102 that has the capability of a GPS navigation device) (Column 8, line 64 to column 9, line 2; and column 9, lines 57-67); and this navigational device (PDA 102) is configured to removably fit within a tray (Fig. 3, the cradle 104). The tray (cradle 104) is mounted on the vehicle dashboard and is similar to those presently used for mounting cellular telephones in automobiles (Column 3, line 63 to column 4, line 5).

Ross fails to disclose a carrying case for enclosing the navigational device.

However, Lewis (GB 2,405,049) discloses (Fig. 3) a carrying case or a hard case (40) for carrying a mobile phone or a remote unit such as a PDA or a computer (Page 5, lines 1-4). This carrying case (40) also includes a GPS navigational device to be used while driving a vehicle (Page 7, lines 1-7).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the carrying case (40) of Lewis for enclosing the navigational PDA device (102) of Ross to protect the navigational PDA from being damaged when a user wants to carry the navigation device on foot around an unfamiliar city or when driving a vehicle (as suggested by Lewis, page 7, lines 1-7).

Regarding the limitation "wherein the case is configured to conform to the tray", Susko (5,996,866) discloses (Fig. 1) a vehicle console (12) having a plurality of containing trays. Susko further teaches that one of the tray (drawer 16) is configured to receive a portable phone (22) in slot (18) and sun glasses (22) in slot (20) (Column 2, lines 19-23).

Therefore, it would have been obvious to the person of ordinary skill in the art to store the carrying case (40) of Lewis in to the tray (16) of Susko to provide a more convenient storing tray for the portable electronic device and its power cord within a the

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vehicle. This tray would allow the driver to easily access the GPS or portable phone when he needs it (as suggested by Susko, column 1, lines 55-58).

Furthermore, it is obvious that one of ordinary skill in the art to store the carrying case (40) on the vehicle dashboard tray, a cup holder tray, or the right hand console tray, as shown in Fig. 1 of Susko, since this is not critical to the function of the GPS device in the carrying case (40) of Lewis.

Regarding claim 2, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup holder tray, or the driver's right hand console tray (as shown in Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices.

Furthermore, if the vehicle has a tray, then it does not matter where it is come from or what time it is put in.

Regarding claim 3, Ross further teaches the tray (cradle 104) is mounted on the vehicle dashboard (Column 3, line 63 to column 4, line 5).

Regarding claim 4, Ross discloses (Figs. 1, 4 and 5) the tray (104) includes electrical connections for connecting the navigational device to a power source and data source supplied by the vehicle (Column 3, lines 16-37).

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Regarding claim 5, Lewis (GB 2,405,049) discloses (Fig. 3) the carrying case (40) includes a base (42) and a hinged lid (44).

Regarding claim 6, it is obvious that the carrying case (40) of Lewis "may" easily and quickly be removed from the tray (16) of Susko.

Regarding claim 7, Lewis further teaches that the carrying case (40) can function as a tuner, a radio, television, or musical MP3 player (Page 7, lines 17-24). It is well known that these above mentioned electronic devices contain speakers.

Regarding claims 8 and 13, Lewis (GB 2,405,049) discloses (Fig. 3) the carrying case (40) comprises a cellular phone or can function as a tuner, a radio, television, or musical MP3 player (Page 6, lines 11-35; and page 7, lines 17-24). It is well known that these above mentioned electronic devices contain speakers.

Furthermore, whether positioning the electronic devices on the base or on the lid of the case is merely an obvious design choice since it is not a critical function to the navigational device.

Regarding claim 31, note the rejection as set forth above with respect to claim 1. Furthermore, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup holder tray, or the driver's right hand console tray (as shown in

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Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices.

Furthermore, if the vehicle has a tray, then it does not matter where it is come from or what time it is put in.

Regarding claims 32-36, note the rejections as set forth above with regard to claims 3-7, respectively.

Regarding claims 40-41, note the rejection as set forth above with respect to claim 1. Susko (5,996,866) further discloses (Fig. 1) a vehicle console (12) having a plurality of containing trays. Susko further teaches that one of the tray (drawer 16) is configured to receive a portable phone (22) in slot (18) and sun glasses (22) in slot (20) (Column 2, lines 19-23). There if no securing mechanism is needed to secure the portable phone (22) in slot (18) and sun glasses (22) in the tray (16). Furthermore, it is well known in the art that a plurality of trays such as vehicle dashboard tray, a cup holder tray, or the driver's right hand console tray (as shown in Fig. 1 of Susko) can be installed during manufacture of the vehicle as a container for containing the drivers' articles such as sunglasses, drinking cup, or electronic devices without any securing mechanism is needed.

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Regarding claim 43, Lewis further teaches that the carrying case (40) can function as a tuner, a radio, television, or musical MP3 player (Page 7, lines 17-24). It is well known that these above mentioned electronic devices contain speakers.

Regarding claim 44, note the rejection as set forth above with respect to claim 8.

Regarding claims 45-46, note the rejections as set forth above with respect to claims 5-6.

Claim Rejections - 35 USC § 103

Claims 14 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Lewis and Susko as applied to claim 1 above, and further in view of Ockerse et al (6,928,366).

Regarding claims 14 and 38, Ross fails to disclose the structure of the GPS device.

However, Ockerse discloses (Fig. 3) a GPS device includes a navigation component (GPS 118 and magnetic sensor circuit 102), a processor (110), a memory (non-volatile memory 112), a display (heading indicator 114), an input (user input 116), and it is well known in the art that these well known components are assembled in the housing. See column 9, line 40 to column 10, line 30.

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Therefore, it would have been obvious to the person of ordinary skill in the art to use the GPS device of Ockerse for the GPS device of Ross to provide a more accurate navigation device.

Claim Rejections - 35 USC § 103

Claims 30, 37, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Lewis and Susko as applied to claims 1 and 31 above, and further in view of Yaski et al (US 2001/0040109).

Regarding claims 30, 37, 39, and 42, Lewis discloses (Fig. 4) the carrying case (40) includes a base (50) and a hinged lid (44).

Both of Ross and Lewis fail to disclose the lid is "operable" to enclose the navigational device, and the lid is "operable" to pivot upwards and rest generally against a top of the navigational device.

However, Yaski (US 2001/0040109) discloses (Fig. 1) a carrying case with a base (2) and a hinged lid (22). The hinged lid (22) is "operable" to enclose the navigational device (GPS 26) when the base (2) is sitting on a flat surface. The hinged lid (22) is also "operable" to pivot upwards and rest generally against the top (28) of the navigational device (26) (Section 2, the last seven lines).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the carrying case with the hinged lid (22) of Yaski for enclosing the navigational PDA device (102) of Ross to protect the navigational PDA from being damaged. Furthermore, this carrying case also allows the user to adjust the viewing angle of the

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navigational device at any desired position (as suggested by Yaski, Abstract, lines 17-20).

Furthermore, regarding the term "operable to function independently..."

The statements of intended use or field of use, "operable to", "adapted to", or "capable of" clause are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP 2114:

"A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2nd 1525, 1528."

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As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

Applicant's arguments filed July 25, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument (pages 15-18) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, "Lewis (GB 2,405,049) discloses (Fig. 3) a carrying case or a hard case (40) for carrying a mobile phone or a remote unit such as a PDA or a computer (Page 5, lines 1-4). This carrying case (40) also includes a GPS navigational device to be used while driving a vehicle (Page 7, lines 1-7).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the carrying case (40) of Lewis for enclosing the navigational PDA device (102) of Ross to protect the navigational PDA from being damaged when a user wants to carry the navigation device on foot around an unfamiliar city or when driving a vehicle (as suggested by Lewis, page 7, lines 1-7)."

Furthermore, "regarding the limitation "wherein the case is configured to conform to the tray", Susko (5,996,866) discloses (Fig. 1) a vehicle console (12) having a plurality of containing trays. Susko further teaches that one of the tray (drawer 16) is configured to receive a portable phone (22) in slot (18) and sun glasses (22) in slot (20), which are conformed to the tray (Column 2, lines 19-23).

Therefore, it would have been obvious to the person of ordinary skill in the art to store the carrying case (40) of Lewis in to the tray (16) of Susko to provide a more convenient storing tray for the portable electronic device and its power cord within a the vehicle. This tray would allow the driver to easily access the GPS or portable phone when he needs it (as suggested by Susko, column 1, lines 55-58).

Furthermore, it is obvious that one of ordinary skill in the art to store the carrying case (40) on the vehicle dashboard tray, a cup holder tray, or the right hand console tray, as shown in Fig. 1 of Susko, since this is not critical to the function of the GPS device in the carrying case (40) of Lewis."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Burrell (6,411,502) discloses (Fig. 7) a navigational device being stored in a recess (94) in a dash (95) of a vehicle (Column 6, line 63 to column 7, line 17).

-Hatcher (4,946,120) discloses (Fig. 1) a support (10) for securing a lap type computer (14) to a car seat (12).

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-Gregory (6,273,310) discloses (Figs. 7-10) a portable laptop computer workstation.

-Richardson (4,619,386) discloses (Fig. 1) a vehicle desk container.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Luu

A handwritten signature in black ink, appearing to read 'Matthew Luu', with a stylized flourish at the end.

**MATTHEW LUU
PRIMARY EXAMINER**